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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/421,273	10/20/1999	KAORU NARITA	Q56320	3894

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SUGHRUE MION ZINN MACPEAK & SEAS
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EXAMINER

GARCIA, JOANNIE A

ART UNIT PAPER NUMBER

2823

DATE MAILED: 05/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/421,273

Applicant(s)

NARITA, KAORU

Examiner

Joannie A Garcia

Art Unit

2823

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing. It is not depicted "shallow trench isolating regions having a first depth, and provided in surface portions of said semiconductor substrate for defining active areas therebetween", and "a circuit component of an integrated circuit provided in one of said active areas, and connected between said terminal and a first source of constant voltage".

Applicant is given a TWO MONTH time period to submit a drawing in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit a drawing will result in **ABANDONMENT** of the application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15, and 17-30 are rejected under 35 U.S.C. 112, second paragraph, because they are directed to both process of making and product made. As a result, the scope of the claims cannot be determined. See Ex parte Lyell 17 USPQ2d 1548 (8/16/1990).

In claim 1, lines 3-4, it is not clear what is recited through the use of "shallow trench isolating regions having a first depth, and provided in surface portions of said semiconductor substrate for defining active areas therebetween".

In claim 1, lines 6-7, it is not clear what is recited through the use of "a circuit component of an integrated circuit provided in one of said active areas, and connected between said terminal and a first source of constant voltage".

Claims 1-15 have not been rejected over the prior art because, in light of the 35 U.S.C. 112 rejections and the objections to the drawings supra, there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of the claims; hence, it would not be proper to reject the claims on the basis of prior art. As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under 35 U.S.C. 103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-30 are rejected under 35 U.S.C. 101 because they improperly embrace or overlap two different statutory classes of invention, namely, process of making and product made, which statutory classes are set forth only in the alternative in 35 U.S.C. 101. See MPEP 2173.05(p). A drawing depicting the device of claim 17 is required.

Chemical reactivity is a most unpredictable and empirical art and it is well settled that the requirement that the claims be commensurate in scope with the enabling disclosure is particularly stringent in this area of technology. *In re Doumani* 126 USPQ 408, *In re Grant* 134 USPQ 248, *In re Fisher* 166 USPQ 18, *Mobil Oil Corporation v. W. R. Grace and Company* 180 USPQ 418, *In re Slocombe* 184 USPQ 740, *In re Mercier* 185 USPQ 774, *Corona Cord Tire*

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Company v. Dovan Chemical Corporation 192 CD 255, See In re Hawkins 174 USPQ 157 (pg. 163) reasoning is sufficient, evidence is not required.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0956. See MPEP 203.08.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner J. Garcia whose telephone number is (703) 306-5733. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (703) 308-4918. The fax number for this group is (703) 308-7722 (and 7724), and (703) 305-3431 (and 3432). MPEP 502.01 contains instructions regarding procedures used in submitting responses by facsimile transmission.

JAG
5/2/02

Wael Fahmy
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